

5 **REMARKS**

Paragraphs 1-4 of the Office Action

 Claims 1-4 are rejected under 35 USC §102(b) as being anticipated by Savio.

 Claim 1 has been amended to include as filed claims 4 and 5, and will be
10 addressed below with claim 6. Claim 4 has been cancelled.

 Withdrawal of the rejection is respectfully requested by the applicant.

Paragraphs 5-7 of the Office Action

 Claims 5 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over
15 Savio, as applied above, in view of Grille.

 Claim 5 has been cancelled. Claims 1 and 6 each include the elements of a bar
that includes a loop which is extendable through a slot in a cylinder. A lock is attached to
the loop so that the loop is then secured within the cylinder. A bar is positioned within
the cylinder to prevent access to the lock with lock cutters. For this reason, the lock is
20 positioned between the bar and the doorframe.

 The Examiner has cited Savio for a number of elements found in applicant's
device. Applicant respectfully disagrees with the Examiner's classification of those
elements. For instance, element 23 of Savio is cited as a loop to which a lock is attached.
However, element 23 is a bore (column 2, line 68) adapted for receiving the locking
25 bar 25 of a padlock. The loop of applicant's device is *attached* to the arm. This allows it
to extend away from the arm so that it can engage the lock mount. Additionally, the
Examiner cites the base plate 13 and tubular socket 6 as analogous to the locking arm
mount and lock mount of applicant's device though they are not orientated in the same
manner or attached to analogous elements of applicant's device. For instance, the
30 locking arm mount and the lock mount of applicant's device are attached to the sides of
one frame, whereas the base plate and tubular sockets are attached to different frames.
Savio utilizes this orientation because Savio is preventing the two frames from moving
toward each other. Savio is also cited for the use of a pivoting arm, but the pivoting rod
17 of Savio does not function in the same manner as applicant's device. Applicant's arm
35 must pivotal in order to secure the arm in a closed orientation against the door. Savio

5 utilizes a pivotal rod in order to allow the window to be fully opened. Savio already allows the window to be opened by utilizing a telescoping arm, however the rod needs to be swiveled away from the tubular socket in order to fully open the window. Finally, applicant's positioning of the cylinder causes a plane of the door to extend through the cylinder. This feature is neither addressed by the Examiner nor discussed by Grille.

10 However, it is an important element of applicant's device as it defines the spatial relationship between the lock mount, the locking arm mount, the arm and the door. For these reasons, it is believed that any combination including Savio for the purpose of citing the above elements would be deficient in finding the totality of applicant's elements.

15 The Examiner next cites Grille in order to find the elements of the cylinder and the bar. While a cylinder is used in applicant's device, Grille relies on a rod 30 to which a padlock will be attached. Without the rod, the cylinder of Grille would not be attached to the device being locked. Therefore, Grille relies on the rod not for protecting the padlock, but for actually keeping the cylinder around the padlock. Applicant does not use

20 the bar for this purpose which is why applicant has placed the bar adjacent to an outer edge of the cylinder. In this position, the bar will prevent the insertion of a lock cutter into the cylinder so that the padlock will not be cut. This will still allow a person to swivel the padlock within the cylinder to reach the keyhole or combination selector. Grille does not discuss this positioning or feature and therefore Grille is also deficient in

25 showing an element of applicant's device. For these reasons, the combination of Grill and Savio do not form the device as claimed.

Alternatively, if such a combination were to form the device as claimed, such a combination would not be made for lack of motivation. Savio is a window locking device used for keeping a window in a closed position by preventing a window from

30 being lifted toward an upper edge of a frame. Savio's device is a device that is used within a house. For this reason, only the occupants of the house would have access to the lock used in Savio's device. There would be no need to prevent these occupant's from having full access to the lock, even with a lock cutter (such as if the key was lost). A potential intruder would have to break the window and still contend with the window

35 frame and broken glass in order to attempt to cut the lock. Grilles device would have no

5 place on Savio's window lock because it would not be needed. Additionally, applicant
can see no conceivable way of actually incorporating Grille into Savio as the lock in
Savio lies flush against the frame and therefore does not provide the birth needed for the
receiving of a cylinder. Finally, the manner in which Savio positions the padlock
adjacent to the frame makes it inherently difficult to cut with a lock cutter since the
10 padlock will not easily swivel as is the opposite in applicant's case. It is submitted that
when a suggestion or motivation to combine selected elements of prior art references is
not supplied by the prior art (or in this case where the combination can be argued to be
counterintuitive), the incentive to make such a combination can only come from improper
hindsight reconstruction using the applicants' specification.

15 [T]he Examiner relied upon hindsight to arrive at the determination of
obviousness. It is impermissible to use the claimed invention as an instruction
manual or "template" to piece together the teachings of the prior art so that the
claimed invention is rendered obvious. This court has previously stated that
20 '[o]ne cannot use hindsight reconstruction to pick and choose among isolated
disclosures in the prior art to deprecate the claimed invention.' [citations omitted]

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), (in part quoting
from In re Fine, 837 F.2d 1071, 1075; 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

As there is no motivation and as the combination would still not form the device
25 as claimed by applicant, the applicant respectfully requests withdrawal of the rejections.

New Claim

In order to further define applicant's device, new claim 7 includes the limitation
of a method whereby the positioning of the components of the device are defined with
30 respect to the doorframe. No new information has been added and all references therein
are fully supported within the specification and figures as filed. It is applicant's belief
that no new arguments were created by the inclusion of this claim, as the statements
therein were readily obvious from the original claim set.

CONCLUSION

10 In light of the foregoing amendments and remarks, early consideration and
allowance of this application are most courteously solicited.

Respectfully submitted,

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